

REMARKS

Upon entry of the present amendment, claims 1-12 and 19-20 will have been amended to enhance the clarity without narrowing the scope thereof and for reasons unrelated to patentability. Further, no claims will have been newly added or canceled. Accordingly, claims 1-20 are currently pending. Applicant respectfully requests reconsideration of the claims and a withdrawal of the outstanding rejection together with an indication of the allowability of all the claims in the present application, in due course.

In the Official Action, the Examiner rejected claims 11 and 14 under 35 U.S.C. §112, first paragraph. More specifically, the Examiner asserted that the claimed feature of the door being a different shape than the aperture and partially exposing the background design when the door is closed is not supported by the specification.

Applicant, however, traverses the above rejection and submits that support can be found, for example, in the paragraph beginning on line 17 of page 6. In this paragraph, Applicant notes that the door can be modified to change the exposure amount of the background design both when the door is opened or closed by cutting edges of the door. In other words, the door is cut to have a shape different than a shape of the aperture. Based upon at least this passage, Applicant submits that one of ordinary skill in the art would recognize that by cutting edges of the door, the door will be provided with a shape that is different from the aperture. Accordingly, gaps provided, for example, by the cut edges will expose a part of the background design even when the door is closed. Accordingly, as Applicant has clarified the above

P23583.A06

feature for the Examiner in accordance with the disclosure provided in the specification, withdrawal of the rejection and favorable reconsideration is respectfully requested.

The Examiner also objected to claim 1 for minor informalities. In particular, the Examiner asserted that “at least one of background design” lacks antecedent basis. Although Applicant does not agree with the Examiner’s assertions, Applicant has nevertheless amended the recitation to “at least one of the background designs” to enhance the clarity thereof. Accordingly, as the Examiner’s objection is believed to be overcome by such an amendment, Applicant respectfully requests withdrawal of the objection.

Also, the Examiner objected to claim 10 and asserted that “at least one of opens and closes” is unclear. Although Applicant does not agree with the Examiner’s assertions, Applicant has nevertheless amended the recitation (in both claims 10 and 20) to clarify that the door is configured to open and close. As Applicant has amended the claim to overcome the objection, favorable reconsideration is respectfully requested together with withdrawal of the objection.

With respect to the merits of the invention, the Examiner rejected claims 1, 3-4, and 5-7 under 35 U.S.C. §102(b) as being anticipated by D’ANDREA (U.S. Patent No. 5,031,935). Claims 12 and 18 were rejected under 35 U.S.C. §102(b) as being anticipated by FEUER (U.S. Patent No. 4,200,222). Claims 12, 15, and 18 were rejected under 35 U.S.C. §102(b) as being anticipated by WAGNER (U.S. Patent No. 1,028,921). The Examiner also rejected claims 2, 16, and 17 under 35 U.S.C. §103(a) as being unpatentable over D’ANDREA or FEUER or WAGNER. Further, claims 8-11

P23583.A06

and 19-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over D'ANDREA in view of WERZBERGER (5,951,298).

Applicant, however, respectfully traverses each of the above rejections and submits that they are inappropriate with respect to the claims in the present application.

It is a feature of Applicant's invention to provide a designated drawing space, as recited in the claims. By providing several advantageous features, including a drawing space, the book offers an area in which the user may create, complete, supplement, or even contribute to a background design, which is viewable through an aperture.

Accordingly, the recited features allow the user to not only selectively view designs, but also allow the user to express and view his or her creations in conjunction with the viewable designs via a designing area (i.e., a drawing space). However, Applicant submits that these features are not disclosed or even rendered obvious by the cited references.

For example, Applicant notes that D'ANDREA fails to anticipate or even render obvious, inter alia, a coloring book comprising at least a sharing sheet that includes at least one aperture that exposes at least one background design and that is provided with a designated drawing space, as recited in the claims. Rather, in D'ANDREA, the pages (16), which were interpreted by the Examiner as being the sharing sheet, contain illustrations and/or text of a book that is intended to be read and not configured to provide a drawing area. Accordingly, as D'ANDREA is deficient and fails to teach the above feature, withdrawal of the rejection is respectfully requested.

Moreover, Applicant notes that the Examiner improperly rejected claims 3-4 under 35 U.S.C. §102(b) as being anticipated by D'ANDREA. Applicant submits that claims 3-4 depend on claim 2. However, the Examiner rejected claim 2 under 35 U.S.C. §103(a). In this regard, Applicant submits that claims (e.g., claims 3-4) that are dependent upon a claim (e.g., claim 2) that is not anticipated by a reference cannot be properly asserted to be anticipated by the same reference. Thus, withdrawal of the rejection is respectfully requested.

Additionally, Applicant submits that FEUER also fails to disclose or suggest at least one sheet that is provided with a drawing space. Rather, FEUER is directed towards providing a greeting card with a removable decal. Accordingly, FEUER discloses a front portion 12 of a greeting card as containing only an opening and a border. FEUER, however, does not expressly or impliedly disclose or suggest, inter alia, a designated drawing space, as evidenced by a lack of any such disclosure in the specification or drawings of FEUER. Since FEUER is also deficient in disclosing at least this feature, Applicant respectfully requests an indication of the allowability of all of the claims.

Applicant further submits that WAGNER also fails to disclose at least one sheet that is provided with a designated drawing space. In contrast, WAGNER is directed towards a book with leaves having pictures and holes thereon. In WAGNER, the pictures are completed by a design on the cover of the book which are visible through the holes. WAGNER, however, does not disclose or even suggest providing a designated drawing space on the leaves. Accordingly, as such a feature is neither

anticipated or rendered obvious by the disclosure of WAGNER, Applicant respectfully requests withdrawal of the rejection.

Moreover, with regards to each of the Examiner's assertions regarding the inherency of a "drawing space" in setting forth the 35 U.S.C. §102 rejections, Applicant submits that such assertions are improper. More specifically, Applicant submits that when a reference is silent about an asserted inherent characteristic (as in the present case), evidence must make it clear that the missing characteristic is necessarily present in the reference. In other words, the Examiner must present evidence that the asserted inherent characteristic must be present therein. There can be no speculation about such a characteristic. In this regard, the Examiner is requested to review MPEP§2112 regarding the burden of proof and requirements of a rejection based on inherency.

Under these guidelines, the Examiner must provide rationale or evidence tending to show that the missing descriptive matter is necessarily present in the reference. Moreover, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Further, it is the burden of the Examiner to show that the result asserted by the Examiner is the necessary result, and not merely a possible result. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Accordingly, withdrawal of

the rejections is respectfully requested. In the present situation, the Examiner has made no such showing with respect to any of the relied upon documents. Moreover, Applicant respectfully submits that no such showing can be properly made.

Furthermore, regarding the Examiner's assertions that claims 8-11 and 19-20 are rendered unpatentable under 35 U.S.C. §103(a) over D'ANDREA in view of WEZBERGER (U.S. Patent No. 5,951,298), Applicant submits that the rejection is inappropriate as the Examiner has neither presented any implied or explicit suggestion in the references nor motivation for the proposed modification/combination. In this regard, Applicant submits that D'ANDREA is specifically directed towards providing apertures in the pages (16) so that the image (22) appearing through the apertures are able to complete an illustration on the respective pages (16) and so that the image may be viewed when generally referred to in the text (e.g., column 4, line 58 to column 5, line 10). Accordingly, there is no need or motivation to modify D'ANDREA in order to selectively display the images (22) via at least one door, as asserted by the Examiner. That is, the door as taught by WERZBERGER would serve no apparent purpose in the book of D'ANDREA.

Moreover, Applicant submits that WERZBERGER fails to disclose or suggest, inter alia, a pair of background sheets and a sharing sheet placed between the background sheets for being coordinated with the background sheets, as recited. Thus, as discussed above, Applicant respectfully submits that WERZBERGER also fails to provide any implied or explicit suggestion for the combination/modification asserted by the Examiner in the rejection of claims 8-11 and 19-20 under 35 U.S.C. §103(a).

P23583.A06

Accordingly, due to the deficiencies of each of the applied references, Applicant respectfully requests withdrawal of the rejection and passage of the present application to issue.

Thus, in view of the amendments and arguments herein, Applicant submits that claims 1-20 are in condition for allowance. With regard to dependent claims 2-11, 13-18, and 20, Applicant asserts that they are allowable on their own merit, at least because they depend either directly or indirectly from independent claim 1, claim 12, or claim 19 which the Applicant has shown to be allowable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of the claims, as well as indication of the allowability of all of the claims.

SUMMARY AND CONCLUSION

Applicants believe that the present application is in condition for allowance, and respectfully request an indication to that effect. Applicants have amended the claims to enhance clarity only and argued their allowability. Accordingly, reconsideration of the outstanding Official Action and allowance of the present application and all the recited claims therein are respectfully requested and now believed to be appropriate.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Commissioner determine that an extension of time is required in order to render this response timely and/or complete, a formal request for an extension of time, under 37 C.F.R. §1.136(a), is herewith made in an amount equal to the time period required to render this response timely and/or complete. The Commissioner is authorized to charge any required extension of time under 37 C.F.R. §1.17 to Deposit Account No. 19-0089.




P23583.A06

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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